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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/984,178 12/03/97 HORVITZ

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KRISTINA BIEKER BRADY PHD  
CLARK & ELBING LLP  
176 FEDERAL STREET  
BOSTON MA 02110

EXAMINER

SHUKLA, R

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 03/01/01

17

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Advisory Action**

Application No.

08/984,178

Applicant(s)

HORVITZ ET AL.

Examiner

Ram R Shukla

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 November 2000 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☐ they raise the issue of new matter. (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

4. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
5. ☒ Newly proposed or amended claim(s) 1, 3, and 4 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☐ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: none.
- Claim(s) objected to: none.
- Claim(s) rejected: 1-4, 8, 12-15, 17, 18, 21, and 36.
- Claim(s) withdrawn from consideration: 2, 5-7, 16, 19, 20, 23-24, 28-32, 34, 37-39, and 41-68.
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
11. ☒ Other: Claims 12-14 will be allowable if they are presented as independent claims reciting SEQ ID NO 18.

Continuation of 3. NOTE: Amended claim 8 recites a mutated nucleic acid sequence whereas claim 8 as presented earlier recited a nucleic acid encoding a mutant polypeptide, therefore it raises new issues. Amendment to claims 8, 15, 17, 18, 21, and 36 do not obviate the 112 first para scope of enablement rejection because the specification is not enabling for the broadly claimed nucleic acids. Claim 69 is a new claim dependent on claim 17 and limits the invention of claim 17 to a nematode nucleic acid. Claim 21 will require a new search and raises new 112 2nd para issue, for example in (e), invention recites 'encoded by at least two other genes' which would indicate 'other than SEQ ID NO 18', however in line 3 of (e) it recites that one of said two other genes is SEQ ID NO 18. It is not clear as to how can SEQ ID 18 be considered other than SEQ ID NO 18.

Continuation of 6. does NOT place the application in condition for allowance because: Applicants' arguments have been fully considered, however, they are not persuasive. It is noted that most of these arguments have been reiterated as in the response of 8-31-99. New arguments directed to amended claims are not addressed. Applicants' arguments that the specification has described ced-3 genes from two other nematodes, *C. briggsae* and *C. vulgaris* and that description in the specification is sufficient to indicate that the applicants had the possession of the recited sequences at the time of the invention are not persuasive because claim 17 is not limited to nematode ced-3 gene but encompasses ced-3 from any living organism. Therefore, the 112 rejections are maintained. Regarding 102 rejection, it is noted that applicant's arguments are not persuasive regarding claims 17 and 18 because the recitation of 'purified' and SEQ ID NO 18 does not obviate the rejection. It is noted that since claims recite 'comprising', a cosmid would still encompass the sequences claimed unless a particular SEQ ID NO is recited because a cosmid DNA containing an exogenous DNA segment is also isolated and purified. Additionally, ced-3 gene of Yuan is structurally and functionally related to SEQ ID NO 18.

*Scott D. Pribe*  
SCOTT D. PRIEBE, PH.D  
PRIMARY EXAMINER



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# Fax Cover Sheet

Date: 22 Mar 2001

To: Kristina Bieker-Brady	From: Ram R Shukla
Application/Control Number: 08/984,178	Art Unit: 1632
Fax No.: 617-428-7045	Phone No.: (703) 305-1677
Voice No.:	Return Fax No.: (703) 308-8724
Re:	CC:

☐ Urgent ☐ For Review ☐ For Comment ☐ For Reply ☒ Per Your Request

Comments:  
Ms. Bieker-Brady,

Please find attached the continuation sheet for the advisory action of 3-1-01.

Thank you,

*RS*  
Ram R. Shukla, Ph.D.

Number of pages 2 including this page

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Assistant Commissioner for Patents